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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,632	05/03/1999	CHERYL B. LEBEAU	D-7102	8616
44885 7590 01/02/2008 ARTHUR G. YEAGER, P.A. 245-1 EAST ADAMS STREET JACKSONVILLE, FL 32202-3336			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/303,632

**Applicant(s)**

LEBEAU ET AL.

**Examiner**

Leslie J. Evanisko

**Art Unit**

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-32, 37, 38, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) 22, 23, 27, 30, 31 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 24-26, 28, 29, 32, 37, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Election/Restrictions**

1. Applicant's election of Species II of Figures 6-7 in the reply filed on May 24, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). It is noted that applicant states the traversal is due to claim 21 being a generic claim. However, the fact that claim 21 may be generic does not mean that the claims are not restrictable. Therefore, this statement by applicant fails to distinctly and specifically point out the supposed errors in the restriction requirement.

2. Claims 22-23, 27, 30-31, and 38 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 24, 2007.

### **Drawings**

3. The replacement sheets of drawings were received on December 20, 2006. These drawings are approved by the Examiner.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21, 24-26, 28-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claim 21 has been amended to state "said sheet having no adhesive distributed on either face of the sheet and being void of any electrical charge". This language appears to be new matter as it is not supported by the original disclosure and in fact, is inconsistent with the disclosure. In particular, it is noted on page 5, lines 7-21 and page 6, lines 9-11 that applicant discloses strips of adhesive provided on the cover to aid in attaching it to the keyboard or for fastening the open edge of the cover closed. Additionally, the specification is completely silent with respect to whether the sheet is void of any electrical charge. Therefore, there is no sufficient basis for this claim language present in the ORIGINAL disclosure.

Appropriate correction and/or clarification is required.

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 21, 24-26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaible et al. (US 5,399,182) in view of the IBM Technical Disclosure Bulletin, June 1994, Vol. 37, Issue 6B, pages 125-126 (hereafter referred to as the IBM reference). Gaible et al. teach an individual transparent bag or "cover" consisting essentially of (i.e., "comprising") a pair of identical flat and entirely transparent planar sheets of uniform thickness pliable plastic film being fastened along at least a bottom edge so as to envelope entire upper and bottom surfaces of a keyboard within the

enclosure formed by the upper and lower sheet members. Note the sheets of Gaible et al. have no adhesive distributed on either face and are void of electrical charge as recited. See Figure 2 and column 4, lines 34-38 of Gaible et al.

Note that although Gaible et al. do not necessarily teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and has no patentable significance to the claims. Thus, Gaible et al. teach a "cover" including all of the structure as recited.

Furthermore, although Gaible et al. is silent with respect to whether it includes a package containing a plurality of such bags, the provision of a plurality of disposable items in a package is well known in the art as exemplified by commercially available packages of such disposable items as sandwich bags, trash bags, etc. Furthermore, the IBM reference teaches packs of individual disposable covers for covering handheld computer devices in the fourth paragraph on page 126. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pack having a plurality of the bags of Gaible et al. to facilitate discarding and replacing the covers as they become soiled or damaged.

With respect to claim 24-26, note that Gaible et al. teach a sheet including an upper member and lower member formed as an envelope with an elongated opening along a top edge portion so as to be capable of contacting and protecting the entire upper surface and lower surface of a keyboard as broadly recited.

With respect to claims 28 and 29, note that Gaible et al. teaches the sheet is comprised of two identical flat sheets that are fastened together along each short side edge portion and along the elongated bottom edge portion with an opening formed along the elongated top edge portion that is capable of permit a keyboard to be inserted therein as recited.

9. Claims 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US 5,812,188). Yanagisawa teaches a keyboard and an individual disposable transparent cover **34, 34'** consisting essentially of a flat and entirely transparent planar sheet of pliable film of uniform thickness and a predetermined size in length and width for forming an envelope or enclosure (column 11, lines 36-37) for enclosing the entire keyboard as recited. See Figures 9-10 and column 11, lines 21-67 in particular. Note that the keyboard of Yanagisawa is rectangular as shown in Figure 6 and therefore, it would appear that the sheet for enclosing the entire keyboard would also be rectangular with long top and bottom edges and short side edges as recited. Furthermore, note that although Yanagisawa does not specifically state that the cover is a plastic film as recited, note that Adair teaches the use of flexible transparent materials such as polyurethane, polyolefins, and laminated plastic films for a covering for a keyboard in a sterile environment is well known in the art. See Figures 1 and 5 and column 5, lines 2-16 and column 6, lines 38-55. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use a plastic film as taught by Adair for the flexible transparent film of cover of Yanagisawa as

it would require simply the obvious selection of a known material based upon its known properties.

With respect to claim 37, note Yanagisawa teaches the concept of enclosing the keyboard with a transparent cover as recited. Although Yanagisawa is silent with respect to the particular details of the enclosure configuration, Adair teaches a keyboard cover including a sheet formed as an envelope with an elongated opening along a top edge portion to allow for insertion of the keyboard as broadly recited is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide the cover member of Yanagisawa to be configured as an envelope with an elongated opening along a top edge portion as taught by Adair to a flexible transparent cover for use in a sterile environment with an opening for allowing insertion of the keyboard inside the enclosure.

10. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US as applied to claims 32 and 37 above, and further in view of Gaible et al. (US 5,397,182).

Yanagisawa as modified by Adair teach a rectangular keyboard 21 and disposable transparent cover 34, 34' individually formed and having a predetermined size to enclose the keyboard (i.e., cover both the upper and bottom surface of the keyboard) for protecting the sterility of the keyboard and inhibiting any unintentional contact between the keyboard and fingers of a user while not impeding an operator's ability to manipulate the keyboard in an accurate and speedy manner. Note the previous



comments with respect to claims 32 and 37. Yanagisawa as modified by Adair do not teach the cover including two identical flat plastic sheets fastened together along the various edges as recited. However, note that fastening two identical flat and entirely transparent sheets of pliable plastic film together along three edges to form an enclosure or “cover” member for enclosing an object is well known in the art, as exemplified by Gaible et al. in Figure 2 and column 4, lines 34-38. In view of this teaching, it would have been obvious to one of ordinary skill in the art to form the enclosure or “cover” of Yanagisawa as modified by Adair from two identical flat sheets fastened together along three edges as taught by Gaible et al. to provide a simple, inexpensive, and easy-to-manufacture cover member to better protect the sterility of the keyboard by enclosing the keyboard to cover both the upper and bottom surfaces of the keyboard and to allow for easy removal of the keyboard.

### **Response to Arguments**

11. Applicant's arguments with respect to claims 21, 24-26, 28-29, 32, 37, 41, and 42 have been considered but are moot in view of the new ground(s) of rejection.

In particular, it is noted that MPEP 2111.03 states that “For the purposes of search for and applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent of “comprising”. Since the applicant has not clearly set forth what the basic and novel characteristics are, the

Examiner has interpreted the claims are being equivalent to open terminology such as "comprising" and therefore the rejections set forth above are deemed to be appropriate.

### Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*/Leslie J. Evanisko/*  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
December 22, 2007